

REMARKS

The Examiner rejected claims 10 and 21 under 35 U.S.C. §112, second paragraph.

The Examiner rejected claims 1, 10-12 and 21-23 under 35 U.S.C. §102(c) as allegedly being anticipated by US Pat No 6,381,579 issued to Gervais et al.

The Examiner rejected claims 1-3, 7-9, 12-14, 18-20 and 23 under 35 U.S.C. §102(b) as allegedly being anticipated by US Pat No 5,855,014 issued to Smith.

The Examiner rejected claims 4-6 and 15-17 under 35 U.S.C. §103(a) as allegedly being unpatentable over Smith (USP 5,855,014).

Applicants respectfully traverse the §112, §102 and §103 rejections with the following arguments.

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35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 10 and 21 under 35 U.S.C. §112, second paragraph, alleging that "claims 10 and 21 contain the trademark/trademark name Lotus, Lotus Domino and Lotus Notes."

In response, Applicants respectfully contend that "Lotus" does not appear in claim 10 and/or claim 21.

In further response, Applicants respectfully contend that "Lotus Domino" does not appear in claim 10 and/or claim 21.

In yet further response, Applicants respectfully contend that "Lotus Notes" does not appear in claim 10 and/or claim 21.

Next, Applicants quote claims 10 and 21, which clearly shows that none of the trademarks of "Lotus", "Lotus Domino", and "Lotus Notes" appear in claim 10 and/or claim 21.

Claim 10 recites: "The method of claim 1, wherein the first agent is a L-script."

Claim 21 recites "The system of claim 12, wherein the first agent is a L-script operating within a LD-software environment, and wherein the database structure includes LN-databases."

The phrases "L-script", "LD-software environment", and "LN-databases" in claims 10 and 21 are not trademarks and identify specific commercial software whose characteristics are well known in the art.

Applicants further note that the prior art reference Smith (USP 5,855,014), cited by the Examiner in the present office action, recites "Lotus Notes" in claims 2 and 9. Applicants assert that claims 2 and 9 in Smith enjoy the legal presumption of being patentable. In addition, the following issued patents recite "Lotus Notes" in claims and enjoy the legal presumption of being

patentable : USP 6,604,150; USP 6,529,900; USP 6,377,950; USP 6,343,297; USP 6,336,217; USP 6,327,594; USP 6,233,583; USP 6,094,655; and USP 5,890,163. The preceding evidence demonstrates that the United States Patent and Trademark Office recognizes that "Lotus Notes" identifies specific software to a person of ordinary skill in the art. In contrast, Applicants do not even recite "Lotus Notes" in claims 10 and 21. Yet, the Examiner alleges that claims 10 and 21 are not patentable. Thus, the rejection of claim 10 and 21 under 35 U.S.C. §112, second paragraph seems inconsistent with the policy of the United States Patent and Trademark Office of allowing claims containing "Lotus Notes", and Applicants do not even recite "Lotus Notes" in claims 10 and 21.

If the Examiner still contends that claims 10 and 21 "contain the trademark/trade name Lotus, Lotus Domino and Lotus Notes, then Applicants respectfully request that the Examiner clarify the Examiner's argument in light of Applicants' preceding argument.

35 U.S.C. §102(e): Gervais

The Examiner rejected claims 1, 10-12, and 21-23 under 35 U.S.C. §102(c) as allegedly being anticipated by US Pat No 6,381,579 issued to Gervais et al..

Applicants respectfully contend that Gervais does not anticipate claims 1, 12, and 23, because Gervais does not teach each and every feature of claims 1, 12, and 23.

As a first example of why Gervais does not anticipate claims 1, 12, and 23, Gervais does not teach "a dynamically changing list of control documents".

The Examiner argues that Gervais discloses "generating a dynamically changing list of control documents [ACL, col 4, lines 55-65, Fig 3, col 7, lines 27-40]" .

In response, Applicants respectfully contend that Gervais does not teach that the Default User Access Control List (ACL) is "a dynamically changing list of control documents". In fact, the only information provided by Gervais about the content of the ACL is an identification of "groups used to manage the access to the resource links" (see Gervais, col. 15, lines 47-50).

Applicants respectfully request that the Examiner present a citation in Gervais showing that Gervais teaches that the ACL is "a dynamically changing list of control documents".

As a second example of why Gervais does not anticipate claims 1, 12, and 23, Gervais does not teach "processing by a first agent a first approved control document on the list".

The Examiner argues that Gervais discloses "processing by a first agent a first approved control document on the list [EnterpriseXspan Environment Server col 4, lines 30-42]" .

In response, Applicants reiterate that the Examiner has identified the ACL as "the list", and that col. 4, lines 30-42 of Gervais does not teach that the EnterpriseXspan Environment

Server processes a first approved control document on the ACL, as required by claims 1, 12, and 23.

Based on Applicants' preceding arguments, Applicants respectfully maintain that Gervais does not anticipate claims 1, 12, and 23, and that claims 1, 12, and 23 are in condition for allowance. Since claims 10-11 depend from claim 1, Applicants contend that claims 10-11 are likewise in condition for allowance. Since claims 21-22 depend from claim 12, Applicants contend that claims 21-22 are likewise in condition for allowance.

In addition with respect to claims 11 and 22, Gervais does not teach "wherin executing a first task on the first approved control document includes replacing a name of a first person with a name of a second person in a plurality of databases of the database structure."

The Examiner argues: "Gervais discloses wherin executing a first task on the first approved control document includes replacing a name of a first person with a name of a second person in a plurality of databases of the database structure [col 4, lines 55-65]."

In response, Applicants respectfully contend that col. 4, lines 55-65 of Gervais does not teach the preceding feature of claims 11 and 22. For example, col. 4, lines 55-65 of Gervais does not teach that replacing a name of a first person with a name of a second person is a task on a control document appearing in an ACL. As another example, Gervais does not teach that said "replacing" is performed in "a plurality of databases".

35 U.S.C. §102(b): Smith

The Examiner rejected claims 1-3, 7-9, 12-14, 18-20 and 23 under 35 U.S.C. §102(b) as allegedly being anticipated by US Pat No 5,855,014 issued to Smith.

Applicants respectfully contend that Smith does not anticipate claims 1, 12, and 23, because Smith does not teach each and every feature of claims 1, 12, and 23.

As a first example of why Smith does not anticipate claims 1, 12, and 23, Smith does not teach "a dynamically changing list of control documents".

The Examiner argues that Smith discloses "generating a dynamically changing list of control documents [workflow control document col 1, lines 30-44, col 7, lines 7-51]".

In response, Applicants respectfully contend that Smith does not disclose that the workflow control document, which the Examiner alleges to be a list of control documents, is a dynamically changing list of control documents, as required by claims 1, 12, and 23. Applicants maintain that col 1, lines 30-44 or col 7, lines 7-51 of Smith absolutely does not teach that the list of control documents (that is allegedly comprised by the workflow control document) is a dynamically changing list. In fact, there is no teaching in Smith that the list of control documents (that is allegedly comprised by the workflow control document) is not a static list of control documents.

In addition with respect to claim 1 specifically, although Smith discloses the existence of the workflow control document, Smith does not disclose generating the workflow control document, as required by claim 1 through the language of "generating a dynamically changing list of control documents". Smith is totally silent as to how the existence of the workflow control document is implemented. Smith most certainly does not disclose the "generating" aspect of

claim 1.

As a second example of why Smith does not anticipate claims 1, 12, and 23, Smith does not teach "processing by a first agent a first **approved** control document on the list" (emphasis added). Applicants' specification states on page 3, lines 18-21: "An "approved" control document is a control document that has been approved for having its enumerated tasks carried out immediately or as soon as possible thereafter." Applicants maintain that there is most certainly no disclosure by Smith that any control document allegedly listed on the workflow control document is "approved" as defined in Applicants' specification.

As a third example of why Smith does not anticipate claims 1, 12, and 23, Smith does not teach "wherein processing the first approved control document includes **causing** executing at least one task on the first approved control document, and wherein executing a task on the first approved control document includes updating the database structure" (emphasis added).

As to "updating the database structure" the Examiner argues: "wherein executing a task on the first approved control document includes updating the database structure [col 14, lines 25-67]."

In response, Applicants maintain that the language of claims 1, 12, and 23 requires that the processing of the first control document cause the updating of the database, which Smith does not teach. In contrast, Smith teaches in col. 14, lines 54-56: "Each action also typically works with data that will be placed into a target document that is located within a target database." The preceding quote from Smith does not teach that the processing of the action will cause the

updating of the database. In fact, the preceding quote from Smith does not even indicate any logical connection or time connection between the processing of the action and the updating of the database. The preceding quote from Smith teaches only that the processing of the action will work with data that will be placed in a database. Thus, the preceding quote from Smith teaches that the data that will be placed in a database irrespective of the performing of the action. Therefore, Smith does not teach that the processing of the first control document causes the updating of the database, as required by claims 1, 12, and 23.

Based on Applicants' preceding arguments, Applicants respectfully maintain that Smith does not anticipate claims 1, 12, and 23, and that claims 1, 12, and 23 are in condition for allowance. Since claims 2-3 and 7-9 depend from claim 1, Applicants contend that claims 2-3 and 7-9 are likewise in condition for allowance. Since claims 13-14 and 18-20 depend from claim 12, Applicants contend that claims 13-14 and 18-20 are likewise in condition for allowance.

In addition with respect to claims 2 and 13, Smith does not teach "generating a view of the list; and accessing the view by the first agent prior to processing the first approved control document."

The Examiner argues: "Smith discloses generating a view of the list and accessing the view by the first agent prior to processing the first approved control document [col 5, lines 55-62]."

In response, Applicants respectfully contend that col. 5, lines 55-62 of Smith is silent as to the existence of a view of the "list of control documents". Indeed, Smith, col. 5, lines 63-65

states: "A view is like a table of contents for a database, except that a view doesn't necessarily list every document in the database, and a single database may have multiple views, each organizing the documents differently" (emphasis added). Thus, there is no teaching in Smith of the existence of a view of the "list of control documents".

Moreover, even if Smith teaches the existence of a view of the "list of control documents" (which Smith doesn't teach), Smith does not teach that said view is accessed by the first agent (i.e., the "single executable software program" which is alleged by the Examiner to be the "first agent") as required by claims 2 and 13. The only entities disclosed by Smith to have access to views are users and developers (see Smith, col. 5, lines 56-59). Therefore, Smith does not anticipate claims 2 and 13.

In addition with respect to claims 3 and 14, Smith does not teach "wherein executing a first task on the first approved control document includes executing the first task by the first agent".

The Examiner argues: "Smith discloses wherein executing a first task on the first approved control document includes executing the first task by the first agent [col 2, lines 18-45]".

In response, Applicants respectfully contend that executing the first task by the first agent includes updating the database structure (see claims 1, 12, and 23). However, the Examiner's citation of Smith, col. 14, lines 25-67 does not teach that the "single executable software program" (which the Examiner alleges to be the first agent) updates the database structure. As explained *supra*, Smith teaches in col. 14, lines 54-56: "Each action also typically works with data that will be placed into a target document that is located within a target database." The preceding

quote of Smith does not provide any information as to who updates the database. Therefore, Smith does not teach that the "single executable software program" updates the database, as required by claims 3 and 14. Therefore, Smith does not anticipate claims 3 and 14.

In addition with respect to claims 7 and 18, Smith does not teach "wherein executing a first task on the first approved control document includes updating a plurality of databases of the database structure".

The Examiner argues: "Smith discloses wherein executing a first task on the first approved control document includes updating a plurality of databases of the database structure [step 5, col 2, lines 15-45]".

In response, Applicants acknowledge that Smith teaches (in col. 2, lines 1-7) updating a plurality of databases as a specified task on a target information form. However, claims 7 and 18 also require that said updating of a plurality of databases be included within an executing of a first task on the first approved control document that appears on the list of control documents. The Examiner has identified the workflow control document as allegedly comprising a list of control documents. Smith identifies the eight fields of the workflow control document in col. 7, line 21 - col. 8, line 9, which clearly shows that the target information form is not one of the control documents listed on the workflow control document. In fact, a link to the target information form appears in field 3 of the action information form (see Smith, col. 10, lines 4-10). Therefore, the updating of the plurality of databases is not a task included on a control document appearing in the list of control documents of the workflow control document. Therefore, Smith does not anticipate claims 7 and 18.

In addition with respect to claims 8 and 19, Smith does not teach "wherein executing a first task on the first approved control document includes updating a first database of the database structure, and wherein executing a second task on the first approved control document includes updating a second database of the database structure".

The Examiner argues: "Smith discloses wherein executing a first task on the first approved control document includes updating a first database of the database structure, and wherein executing a second task on the first approved control document includes updating a second database of the database structure [step 5, col 2, lines 15-45]."

In response, Applicants refer to Applicants' arguments *supra* for claims 7 and 18 in relation to updating a plurality of databases. Additionally, Smith does not disclose in col. 2, lines 15-45 that executing a first and second task comprises updating a first and second database, respectively. Therefore, Smith does not anticipate claims 8 and 19.

In addition with respect to claims 9 and 20, Smith does not teach "wherein a first task and a second task on the first approved control document are not independent."

The Examiner argues: "Smith discloses wherein a first task and a second task on the first approved control document are not independent [col 7, lines 25-52]."

In response, Applicants respectfully contend that col. 7, lines 25-52 of Smith does not teach that a first task and a second task on the first approved control document are not independent. Therefore, Smith does not anticipate claims 9 and 20.

35 U.S.C. §103(a)

The Examiner rejected claims 4-6 and 15-17 under 35 U.S.C. §103(a) as allegedly being unpatentable over Smith (USP 5,855,014). Since claims 4-6 depend from claim 1, which Applicants have argued *supra* to be patentable under 35 U.S.C. §102, Applicants maintain that claims 4-6 are not unpatentable under 35 U.S.C. §103(a). Since claims 15-17 depend from claim 12, which Applicants have argued *supra* to be patentable under 35 U.S.C. §102, Applicants maintain that claims 15-17 are not unpatentable under 35 U.S.C. §103(a).

In addition, Smith does not teach or suggest: "wherin executing a first task on the first approved control document includes directly calling a second agent by the first agent and executing the first task by the second agent" (claims 4 and 15); "wherin executing a first task on the first approved control document includes indirectly calling a second agent by the first agent and executing the first task by the second agent" (claims 5 and 16); and "further comprising processing by a second agent a second approved control document on the list, wherein processing the second approved control document includes causing executing at least one task on the second approved control document, and wherein executing a task on the second approved control document includes updating the database structure" (claims 6 and 17).

The Examiner admits that Smith does not teach the preceding features of 4-6 and 5-17. The Examiner argues that it would be obvious to modify Smith to include the preceding features of 4-6 and 5-17 "for the purpose of dividing the program into well-defined modules".

In response, Applicants respectfully contend that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Smith "for the

purpose of dividing the program into well-defined modules" in relation to claims 4-6 and 5-17. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See Karsten Mfg. Corp. v. Cleveland Gulf Co., 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also In re Gordon, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the motivation obvious unless the prior art suggested the desirability of the modification.").

Thus, the Examiner has not made any showing of where the prior art suggests a modification "for the purpose of dividing the program into well-defined modules". Thus, the Examiner has provided a reason for the combination by speculation derived from the Examiner, and not by teachings of the prior art. By not citing any suggestion or incentive in the prior art "for the purpose of dividing the program into well-defined modules", the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 4-6 and 15-17.

In addition, even if the Examiner were to provide pertinent citations from the prior art, the Examiner would also have to establish that modularizing the program is an obvious modification of Smith. In other words, since there is a price to pay for modularization (e.g., modularization reduces execution speed by introducing the overhead of calling and linking modules, including the passing of data between modules), why would modularization make sense for Smith's invention?

Might the Examiner's suggestion be in conflict with Smith's teaching? (i.e., there is presumably a reason for the word "singly" in Smith's "singly executable software program").

But the Examiner must also demonstrate why particular features of claims 4-6 and 15-17 would be obvious modifications of Smith. As a first example, one could implement modularization without using the "direct calling" feature of claims 4 and 15. As a second example, one could implement modularization without using the "indirect calling" feature of claims 5 and 16. As a third example, one could implement modularization without using the "updating the database structure" (by the second agent) feature of claims 6 and 17. The Examiner has not even addressed any alleged obviousness associated with the preceding particular features of claims 4-6 and 15-17.

Accordingly, Applicants respectfully contend that claims 4-6 and 15-17 are not unpatentable over Smith under 35 U.S.C. §103(a).

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CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below.

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